

REMARKS

At present, applicants' Claim 22 is objected to because of a minor typographic informality which is corrected herein. Applicants' Claims 1-8 and 11-14 stand rejected under 35 U.S.C. § 103(a) based upon the patent to Motoyama et al. (U.S. Patent Number 6,009,436 issued December 28, 1999). Additionally, Claims 9-10, 15-21 and Claim 27 stand rejected under 35 U.S.C. § 103(a) based upon the aforementioned patent to Motoyama et al. in view of a citation from the Microsoft Computer Dictionary published in 1997. Claims 22, 23, 25, and 28 stand rejected under 35 U.S.C. § 103(a) based upon both the patent to Motoyama et al. in further view of the patent to Mitchell et al. (U.S. Patent Number 5,497,491 issued March 5, 1996). Additionally, it is also noted that the Examiner has indicated that Claims 13, 24, 26, and 29 are merely objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form. In light of the comments presented below all of these rejections are respectfully traversed.

It is initially noted that the Examiner has indicated that certified copies of the priority documents have not been received. Enclosed please find a copy of the first page of the priority document Patent Application No. 00104922.0 that was submitted in its entirety with the filing of the Patent Application on March 6, 2001. Also enclosed is a copy of the postcard receipt indicating that the Patent Office received the priority document on March 6, 2001.

With respect to the objection to Claim 22, as indicated above, it is noted that this typographical error has been corrected in the amendment listed above.

Attention is now directed to the rejection of applicants' claims under 35 U.S.C. § 103(a) all of which are based upon the patent to Motoyama et al. While there is a certain superficial similarity between applicants' claims and the teachings found in

Motoyama et al., a close reading of this patent clearly suggests that applicants' claims recite significantly different subject matter. However, before discussing the specifics of the art cited, it is perhaps useful to consider the nature of what applicants are claiming as their invention. In particular, applicants are concerned with automatic but selective conversion of data found in different encoding formats. In applicants' claimed method, a flag is provided which indicates whether or not automatic conversion should be allowed or not allowed. Additionally, there is associated with the data an encoding scheme identifier which particularly indicates the coding scheme employed for that data. In particular, in applicants' claimed process the coding or mapping between the one form of the data and another form of the data is known a priori. Furthermore, in applicants' claimed method, the mapping is generally from a fixed amount of data to another fixed sized amount of data. For example, this is typically the case when one converts from an ASCII form to an EBCDIC form. However, it is noted that slight variations of this exact size matching for the data does occur in situations involving unicode mapping since unicode data encoding maps one character into 2 bytes (16 bits of data). However, apart from this minor variation which is easily accounted for when the encoding scheme identifier indicates that the data is encoded in the unicode format, the conversion contemplated by the present applicants is from a fixed amount of data in terms of bits to another fixed amount of data in terms of bits.

In light of this description of the claimed invention, a comparison with the teachings found in the patent to Motoyama et al. is now appropriate. In this regard, it is first noted that Motoyama et al. do not disclose an automatic conversion process. The Examiner nonetheless indicates that the background section in the Motoyama et al. patent (column 2, lines 42-45) does disclose an automatic conversion process. However, those teachings are specifically limited to conversion of markup language information. More particularly, the essential thrust of the patent to Motoyama et al. is directed to conversion of tag information. In particular, it is noted that in this respect care should be taken not to confuse the recitation of markup language tags which

represent data to be converted with applicants' use of a conversion flag. These are entirely different entities and are used in different fashions.

With respect to the patent to Motoyama et al., it is specifically noted that they do not teach automatic conversion processes. In fact, the essence of their method is the incorporation of user interaction (see their Figure 5 and especially Block 210). In furtherance of this interpretation of the patent to Motoyama et al., the Examiner's attention is specifically directed to the summary of their invention in which it is stated that one of their objects is "to provide a novel method, apparatus and computer program product which can process information encoded in a structured information format to transform the information into another structured information format and which allows the user to interactively define the mapping for the transformation." In the last paragraph in column 2 of the patent to Motoyama et al., it is noted that it is a further one of their objects to allow a user to interactively define the mapping to the transformation, say between a standard generalized markup language SGML format into a hypertext markup language format HTML. It is noted that the tags in these two different formats do not map to one another in a fashion in which the number of characters in one tag matches the number of characters in another tag. In short, there is no way to assure ahead of time any known correlation between the size of the input data and the size of the output data. Even if the mapping were known ahead of time, the variants in the data would produce variances in the size of the output files. In other words, in the method set out in the patent to Motoyama et al., the size of the output is unpredictable from the size of the input. Furthermore, Motoyama et al. specifically require user interaction. In this respect, it is specifically noted that contrary to the Examiner's position, the teachings of Motoyama et al. are such that automatic conversion is specifically taught against. In particular, it is noted (column 2, lines 45-50) that when Motoyama et al. refer to automatic conversion of markup language information, they criticize such automatic conversion because that software "does not allow the user to interactively define the mapping of SGML tags to another format."

Clearly, contrary to the Examiner's position, Motoyama et al. actually teach against any form of automatic conversion. Furthermore, even if one could construe the patent to Motoyama et al. as approving of an automatic conversion process, it is abundantly clear that, in their claimed method, there is no ability to predict the number of bits in the output stream based upon the number of bits in the input stream. This renders automatic conversion and automatic usage by other programs impossible.

In addition to the fact that Motoyama et al. teach against automatic conversion and in addition to the fact that their process is not able to carry out conversions having predictive size capabilities, there are yet other differences found between the claimed invention and the teachings of Motoyama et al. In particular, applicants' claimed invention includes a flag which is set and which either allows or does not allow automatic conversion of the data. There is no such corresponding flag in the patent to Motoyama et al. In the locations in the patent to Motoyama et al. to which the Examiner refers, one does not find a flag, but rather one finds a tag. For example, in the Examiner's reference to column 8, lines 48-52, there is a reference to an SGML tag. This tag represents data to be converted. It is not in any sense a flag which indicates whether or not the entire chunk of data is to be converted automatically or not. Likewise, the other references to locations in the patent to Motoyama et al. point to tags, not to flags. In short, to Motoyama et al., tags are data to be converted; they are not control elements. In contrast, the present applicants regard a flag as an indicator of whether or not automatic conversion is to be allowed. These are entirely different concepts.

It is noted that since all of the rejections of applicants' claims are founded upon the teachings from the patent to Motoyama et al., it is clear that applicants' recited claims are patentably distinct from the teachings found in Motoyama et al. With specific reference to Claim 20, it is noted that Claim 20 does refer to an automatic conversion process, and it further refers to the use of an auto conversion flag. As pointed out

above, Motoyama et al. teach absolutely nothing with respect to the utilization of an auto conversion flag. Again, it is noted that a flag is not a tag. Likewise, applicants' Claim 28 refers to the presence of an automatic conversion component.

Accordingly, from the above, it should be appreciated that those of ordinary skill in the art following the teachings of Motoyama et al. would not actually be led in any way to design, construct, or employ an automatic conversion process. In point of fact, it is clear that Motoyama et al. specifically teach against such processes and specifically also require the ongoing presence of user interaction to define a mapping. Accordingly, claims which include references to automatic conversion or to the presence of an automatic conversion flag would not in any way be rendered obvious by the teachings of Motoyama et al. Accordingly, it is therefore respectfully requested that all of the rejections of applicants' claims 1-29 be withdrawn.

Accordingly, it is now seen that all of the applicants' claims are in condition for allowance. Therefore, early notification of the allowability of applicants' claims is earnestly solicited. Furthermore, if there are any other matters which the Examiner feels could be expeditiously considered and which would forward the prosecution of the instant application, applicants' attorney wishes to indicate his willingness to engage in

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any telephonic communication in furtherance of this objective. Accordingly, applicants' attorney may be reached for this purpose at the numbers provided below.

Respectfully Submitted,

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Die angehefteten Unterlagen stimmen mit der ursprünglich eingereichten Fassung der auf dem nächsten Blatt bezeichneten europäischen Patentanmeldung überein.

The attached documents are exact copies of the European patent application described on the following page, as originally filed.

Les documents fixés à cette attestation sont conformes à la version initialement déposée de la demande de brevet européen spécifiée à la page suivante.

Patentanmeldung Nr. Patent application No. Demande de brevet n°

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Der Präsident des Europäischen Patentamts;
Im Auftrag

For the President of the European Patent Office

Le Président de l'Office européen des brevets
p.o.

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